

## REMARKS/ARGUMENTS

By this paper, Applicant replies to the paper of January 9, 2007 and respectfully requests examination of the application.

Claims 1-7, 10, 11, 15 and 17-57 are now pending, a total of 51 claims. Claims 1, 15, 17, 34, 45 and 56 are independent. As noted below, the paper of January 2007 is procedurally too incomplete to raise any rejection of any claim.

### I. Paragraphs 4 and 5: The § 112 ¶ 2 and § 101 Issues

Even before amendment, the claims were pure method claims. The January 2007 paper incorrectly dissects the claim into “preamble” and “body.” The body starts after the second “comprising,” as clearly indicated by the paragraphing. It is entirely conventional to recite the apparatus of a method-of-using claim in the preamble, and to recite sub-components of the apparatus using “comprising” to indicate that additional subcomponents of the apparatus may exist. For example, a large number of *Jepson* method-of-using claims have apparatus recited in the preamble using “comprising.”

The January 2007 paper cites *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Interf. 1990). *Lyell* illustrates that the correct analysis does not reach the claims of this application. *Lyell*’s preamble is expressly directed to both a “tool” “and method for using same”, and the body of the claim recites both “means plus function” apparatus elements and method steps, joined by the word “and:”

2. An automatic transmission tool in the form of a workstand and method for using same comprising:

a support means,  
and [sic] internally splined sleeve ...  
a threaded adjustment bolt ...,

and further comprising the steps of

1. positioning the output end of an automatic transmission...
2. removing the internal components of said automatic transmission...
3. repairing and replacing said internal components ...
4. adjusting said internal components ...

In contrast, the bodies of the claims of this application are pure methods. The preamble is a pure method-of-using preamble.

No rejection is raised. The amendments to the claims do not relate to any statutory condition for patentability. Any amendment is purely to accommodate the Examiner's personal, non-statutory tastes.

## II. Paragraph 5 of the Office Action

Paragraph 5 of the January 2007 paper is insufficient to constitute a *bona fide* examination of the application, or to raise any rejection of any claim.

37 C.F.R. § 1.104 reads, in pertinent part, as follows:

§ 1.104 Nature of examination.

(a) Examiner's action. (1) ... The examination shall be complete with respect both to compliance of the application ... with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form...

(2) The applicant, or in the case of a reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The reasons for any adverse action or any objection or requirement will be stated and such information or references will be given as may be useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution.

(b) Completeness of examiner's action. The examiner's action will be complete as to all matters, ...

(c) Rejection of claims. (1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

The January 2007 paper does not conform to § 1.104 – it makes no element-by-element comparison of the claim to the art, and does not “designate portions” relied on with any particularity – it merely refers to a single 5-column range for the whole claim and asks Applicant to guess at what the Examiner had in mind.

In a telephone interview of April 10, 2007, the Examiner admitted he could find nothing in Lupien '266, col. 6, line 40 to col. 11, line 20, that remotely related to the claim language “the offer and the bid are brought to market substantially simultaneously.”

In the interview of April 10, 2007, the Examiner asserted that the MPEP authorized examiners to skip careful analysis in some circumstances. Applicant requests the identification of this provision of the MPEP. Applicant further notes that this is unlikely to exist, and if it does exist, cannot be applied as the Examiner suggests, because the MPEP “does not have to force of law or the force of the rule in Title 37 of the Code of Federal Regulations,” MPEP Foreword, and therefore cannot relieve the Examiner’s obligation under the “completeness,” “designate ... as nearly as practicable” and “clearly explain the pertinence” requirements of 37 C.F.R. § 1.104.

In the interview of April 10, 2007, the Examiner shifted to col. 4, lines 48-57. But Lupien’s col. 4 excerpt relates only to a trader’s subjective intent, not to any system that actually implements “the offer and the bid are brought to market substantially simultaneously.” Lupien '266, col. 4, lines 48-57 illustrates the problem – a subjective intent with no automated means to carry out that intention – not the solution, a system that actually brings two orders to market “substantially simultaneously” recited in claim 1.

For these reasons, the January 2007 is procedurally inadequate to raise any rejection of any claim. No rejection could be raised on any designated portion of Lupien '266. Any rejection that might be raised in the future will necessarily be a first consideration of this claim language, and therefore a “new ground of rejection” not necessitated by amendment, preventing final rejection.<sup>1</sup>

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<sup>1</sup> Applicants cannot guess at positions an examiner has not expressed, and are under no obligation to do so or to respond to positions not expressed in the Office’s papers. *Ex parte Berg*, 2002 WL 32346092 at \*2 (BPAI Feb. 6, 2003) (“the examiner must present a full and reasoned explanation of the rejection in the statement of the rejection, specifically identifying underlying facts and any supporting evidence, in order for appellants to have a meaningful opportunity to respond”); *Ex parte Schricker*, 56 USPQ2d 1723, 1725 (Bd. Pat. App. & Interf. 2000) (“The examiner has left applicant and the board to guess as to the basis of the rejection and after having us guess would have us figure out (i.e., further guess) what part of which ... document supports the rejection. We are not good at guessing; hence, we

Independent claims 1, 15, 17 and 45 recite similar language. For reasons that are similar in the context of Lupien '266, these claims are not rejected.

### III. Dependent Claims

The paper of January 2007 is **dead silent** on the following limitations of the following dependent claims:

2. ... generating the parameter based on historical data.
3. ... generating the parameter based on market data that is related to the bid.
4. ... prompting a user to input the parameter.
5. ... generating a price spread between the bid and the offer.
6. ... generating a volume spread between the bid and the offer.
7. ... generating a price spread and a volume spread between the bid and the offer.
10. ... generating the linking parameter based on related market data.
11. ... prompting a user to input the linking parameter.

Such piecemeal examination is forbidden by 37 C.F.R. § 1.104, and discouraged by MPEP § 707.07(g). Any future Office Action should indicate the allowability of any claim that recites a limitation against which no prior art is cited.

Because the January 2007 paper makes no attempt to comply with the PTO's procedures for raising any rejection of these claims, no dependent claim is rejected. If any rejection is raised in any future paper, it will necessarily be a "new ground of rejection" that prevents final rejection.

The dependent claims are patentable with the independent claims discussed above. In addition, the dependent claims recite additional features that further distinguish the art.

### IV. Conclusion

Applicant is sorry that this paper must be so harsh. However, as the Board has noted, when an examiner has not done his/her job, neither applicants nor the Board can do theirs.

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decline to guess."); 37 C.F.R. § 1.111 (applicants are only obligated to respond to issues raised by the examiner).

Applicant sincerely hopes that all future papers from the Office will represent *bona fide* examination and compliance with PTO rules, so that examination and prosecution may proceed cooperatively.

A Petition for Extension of Time extends the statutory period through May, 9, 2007. Accordingly, this reply is timely. In the event that any extension of time is required, Applicant petitions for that extension of time required to make this reply timely.

In view of the amendments and remarks, Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 50-3938, Order No. 00-1027.

Respectfully submitted,

Dated: April 12, 2007

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